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Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 3. This sheet, which includes Figs. 2-3, replaces the original sheet including Figs. 2-3. In Fig. 3, previously omitted element 214 has been added.

Attachment: Replacement Sheet

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Patent**REMARKS**

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-22 are pending in the application. Claims 1-3, 6, 7, 10-14, 17, 18, 21, and 22 have been amended. Claims 8 and 19 have been cancelled. New claims 23-32 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. The above amendments were, in many instances, made to clarify Assignee's claims and do not narrow the scope of the amended claims. Furthermore, in many instances, the above amendments broaden the literal scope of claims and/or claim elements. In light of this, Assignee asserts that no prosecution history estoppel should result from the above amendments, in many instances.

**Claim rejections – 35 USC §112, ¶ 1**

The Examiner rejected claims 4, 5, 15, and 16 under 35 U.S.C. 112, ¶ 1.

The Examiner asserts that while the specification is “enabling for a light-guiding body that “may be incorporated” inside the light-guiding tubes 212 and 218” the specification “does not reasonably provide enablement for a light-guiding body that is incorporated inside the light-guiding tubes 212 and 218”. See page 2 of the Office Action. Specifically, the Examiner asserts that the phrase “may be incorporated” does not mean “is incorporated”.

Assignee respectfully submits that use of the phrase “may be incorporated” in the specification includes, but is not limited to, “is incorporated”. Specifically, the word “may” indicates that the Inventor disclosed embodiments where a light-guiding body “is” incorporated inside the light-guiding tubes.

In any event, the Examiner has not satisfied the PTO's burden to establish that the specification is not enabling since the Examiner did not, for example, address any of the factors to determine whether any experimentation would be undue:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill in the art;

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- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples;
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

See MPEP § 2164.01(b). In fact, the Examiner did not address any of the above factors. The Examiner is kindly reminded that:

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. (emphasis added)

Since the Examiner did not address any of the factors set forth in MPEP § 2164.01(b), the Examiner's conclusion that claims 4, 5, 15 and 16 are not enabled was improper. The Examiner is kindly invited to provide an analysis of all the evidence to each of the above factors in order to satisfy the burden set forth in MPEP § 2164.01(b), or to otherwise withdraw the rejection.

#### Objection to the Drawings

The Examiner has objected to the drawings for not showing a light-guiding body. In response, Assignee has enumerated light-guiding body 214 in Fig. 3, attached hereto.

#### Claim rejections – 35 USC §102(b)

Claims 1, 6, 7, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai et al. (U.S. Patent No. 5,780,829).

It is noted that the Examiner can establish anticipation only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131.01. It is asserted that the Examiner has not established that Tsai meets this requirement.

Assignee has amended independent claim 1 to incorporate limitations from dependent claim 8, to now recite "*a collimating lens located inside the first light-guiding tube*". In the Office Action, the Examiner has conceded that Tsai "does not disclose a collimating lens inside

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the first light-guiding tube of the light source". See page 6 of the Office Action. Accordingly, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Tsai discloses the identical invention as is required for anticipation. See MPEP § 2131.

Claims 6, 7, 10, and 11 as well as new claims 23-32 are similarly not anticipated, at least on the same or similar basis as claim 1.

**Claim rejections – 35 USC §103(a)**

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (U.S. Patent No. 5,780,829) in view of Kerschner et al. (U.S. Patent No. 5,995,243).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142.

Assignee has amended independent claim 1 to incorporate limitations from dependent claim 8, to now recite "*a collimating lens located inside the first light-guiding tube*". In the present Office Action, the Examiner asserts that Tsai discloses "a first light-guiding tube (of light source 32) attached to the body casing". See page 3 of the Office Action. The Examiner has conceded that Tsai "does not disclose a collimating lens inside the first light-guiding tube of the light source". See page 6 of the Office Action. However, the Examiner asserts that "employing a collimating lens in front of a light source to increase the light intensity of light from the light source to an original document is taught by Kerschner et al." Assuming *arguendo* that the Examiner's assertion is correct, the Examiner still has not established a suggestion or motivation to place a collimating lens "*inside the first light-guiding tube*", as recited in independent claim 1. In the absence of the Examiner pointing to such a suggestion or motivation, Assignee respectfully requests that the rejection be withdrawn on the basis that the Examiner has failed to establish a suggestion or motivation modify the reference or to combine reference teachings as proposed by the Examiner.

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Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (U.S. Patent No. 5,780,829) in view of Imamura (U.S. Patent No. 4,769,718). Claims 4, 5 and 9, insofar as the claims are understood to have the light-guiding body incorporated inside the first and second light-guiding tubes, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (U.S. Patent No. 5,780,829) in view of Fukushima et al. (U.S. Patent No. 5,136,150).

In response, Assignee respectfully submits that claims 2, 3, 4, 5, 9 are not obvious, at least on the same or similar basis as claim 1 as set forth above with respect to the anticipation rejection in view of Tsai. Specifically, the Examiner has failed to establish that Tsai teaches or suggests "*a collimating lens located inside the first light-guiding tube*", as recited in independent claim 1. Additionally, Assignee respectfully submits that the Examiner has failed to establish that the proposed combinations cure Tsai of this failure. In the absence of the Examiner pointing to such a disclosure in the proposed combinations, Assignee respectfully requests that the rejection be withdrawn on the basis that the Examiner has failed to establish that the proposed combinations teach or disclose all the claim limitations.

Claims 12, 17, 18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (U.S. Patent No. 5,780,829). Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (U.S. Patent No. 5,780,829) in view of Imamura (U.S. Patent No. 4,769,718). Claims 15, 16 and 20, insofar as the claims are understood to have the light-guiding body incorporated inside the first and second light-guiding tubes, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (U.S. Patent No. 5,780,829) in view of Fukushima et al. (U.S. Patent No. 5,136,150). Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (U.S. Patent No. 5,780,829) in view of Kerschner et al. (U.S. Patent No. 5,995,243).

Like independent claim 1, claim 12 recites "*a collimating lens located inside the first light-guiding tube*". As argued above with respect to the rejection of original dependent claim 8, now incorporated into amended independent claim 1, the Examiner has not established a suggestion or motivation to place a collimating lens "*inside the first light-guiding tube*". In the absence of the Examiner pointing to such a suggestion or motivation, Assignee respectfully requests that the rejection be withdrawn on the basis that the Examiner has failed to establish a suggestion or motivation modify the reference or to combine reference teachings as proposed by the Examiner.

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Claims 13-18, 20-22, and 23-32 are similarly not obvious, at least on the same or similar basis as claim 12.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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**Conclusion**

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

**Invitation for a Telephone Interview**

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,  
Berkeley Law & Technology Group, LLC

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